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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,054	02/11/2002	Siu-Yin Wong	273102008104	9080
7590	04/20/2004			EXAMINER
Karen B. Dow Morrison & Foerster LLP Suite 500 3811 Valley Center Drive San Diego, CA 92130			CHIN, CHRISTOPHER L	
			ART UNIT	PAPER NUMBER
			1641	
DATE MAILED: 04/20/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/074,054	WONG ET AL.	
	Examiner	Art Unit	
	Chris L. Chin	1641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 29 December 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 26-39 is/are pending in the application.
 - 4a) Of the above claim(s) 33-39 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 26-32 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 33-39 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

New independent claims 33 and 39 would have been restricted away from claim 26 if they had been filed with claim 26 because they recite the use of a "web of porous material" in their respective immunoassay devices, which is patentably distinct from the "porous matrix material" now being recited in claim 26. A web of porous material is not the same as a porous matrix material.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 33-39 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Drawings

2. The drawing corrections received on 12/29/03 are acceptable.

Claim Rejections - 35 USC § 112

3. Claim 29 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 29 is vague and indefinite in reciting the phrase "desiccant-like environment" as it is not clear as to what properties of a desiccant are being exhibited in the environment.

Claim 31 is vague and confusing. The recitation of "comprises a polymer and silica" is not clear as to whether the second compartment contains a polymer and silica or that the second compartment is made of polymer and silica.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claim 26 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,763,262. Although the conflicting claims are not identical, they are not patentably distinct from each other for the reasons of record in the previous office action.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 26-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tom et al in view of Svoboda et al and Thomas et al for the reasons of record in the previous office action.

In response to this rejection, Applicants argue that there is a lack of motivation to make the asserted combination of references. Applicants also assert that improper hindsight is being relied upon by the Examiner - "the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner cited".

Motivation for this combination of references was stated in the previous office action. The assay device of Tom et al contains a test strip with immunoassay reagents thereon. Svoboda et al teaches the advantages of using a desiccant to retard the deterioration of reagents on a test strip while Thomas et al shows how to place a desiccant in an assay device that contains test strips. In view of the teachings of Svoboda et al, one of ordinary skill in the art would have recognized the advantages in placing a desiccant in the device of Tom et al for the purpose of maintaining the viability

of the reagents on the test strip by retarding the effects of moisture on the reagents on the test strip.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicants also argue that Tom et al does not teach a "true housing". In response to this argument, it should be noted that the instant claims merely recite "a housing with at least one opening there through for introduction of a liquid sample". The housing in the device of Tom et al has the same structural limitations recited in the instant claims and thus constitutes a "true housing".

The arguments concerning this rejection presented on pages 9-12 of the amendment are directed at each of the references separately. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Arguing the perceived deficiencies

of Tom et al, Svoboda et al, and Thomas et al separately does not address what is taught by the combination of references.

8. Claims 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tom et al in view of Svoboda et al and Thomas et al as applied to claims 26-30 above, and further in view of Moyer et al.

See above for the teachings of Tom et al, Svoboda et al, and Thomas et al. However, Tom et al further differs from the instant invention in failing to teach a housing composed of polystyrene.

Moyer et al (U.S. Patent 3,791,933) discloses a test device comprising a housing, sheets (14) and (16), made of polystyrene sheets and assay disks sandwiched between sheets (14) and (16) (see col. 3, lines 21-67).

It would have been obvious to one of ordinary skill in the art to use polystyrene as the material for the housing in the device of Tom et al, as modified by the teachings of Svoboda et al and Thomas et al, because Moyer et al shows that polystyrene is a conventional and well known material used in the housings of assay devices.

With respect to claim 31, Svoboda et al teaches the use of silica as a desiccant.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chris L. Chin whose telephone number is 571-272-0815. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-0823. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Christopher L. Chin
Primary Examiner
Art Unit 1641

April 19, 2004